

*ES*  
*CS*  
*cont.*

determines an address to which the product was previously shipped, verifies the address, and causes the reordered product to be shipped to the address.

### REMARKS

Applicants respectfully request reconsideration of the present U.S. Patent application. Claims 1, 4, 6, 9, 11, 14, 16 and 19 have been amended. No claims have been canceled or added. Thus, claims 1-20 remain pending.

#### Claim Rejections - 35 U.S.C. § 102

Claims 1-20 were rejected under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent No. 4,835,372 issued to Gombrich et al. (*Gombrich*). For at least the reasons set forth below, Applicants submit that claims 1-20 are not clearly anticipated by *Gombrich*.

Twice Amended Claim 1 recites the following:

providing access to a set of products available for electronic ordering by a user; monitoring products ordered by and shipped to an address associated with the user; and

providing, automatically, in response to subsequent accesses by the user a list of products previously ordered by the user and shipped to the address.

Amended Claim 6 is drawn to a machine-readable medium, and recites similar limitations. Amended Claim 11 is an apparatus claim written in means-plus-function language, and recites similar limitations. Amended Claim 16 is an apparatus claim, and recites similar limitations.

*Gombrich* discloses a physician writing a prescription for a patient, a secretary or other staff person accessing from a terminal a list of drugs in a computer system after

scanning the patient's identification bar code, and entering drug dosages. See col. 14, lines 40-47. The staff person places a patient identification bar code label on the prescription and sends the prescription to the pharmacy for filling. See col. 14, lines 61-64. A pharmacist scans a patient's identification bar code to access the patient's file at the pharmacy terminal and checks the computer's prescription data against the prescription. See col. 14, line 65 – col. 15, line 1. In addition, a computer system records a drug or other item dispensed to a patient in the patient's billing file, which is accessible from a terminal in the billing department. See col. 17, lines 31-36. *Gombrich* thus discloses a first person entering drug dosages in a list of drugs, and different persons later accessing the drug-related information. However, none of the persons ordering the drugs is a person to whom the drugs are shipped. *Gombrich* does not disclose monitoring products ordered by and shipped to an address associated with the user and providing, automatically, in response to subsequent accesses by the user a list of products previously ordered by the user and shipped to the address. Therefore, *Gombrich* does not clearly anticipate the invention as claimed in claims 1, 6, 11 and 16.

Claims 2-5 depend from claim 1. Claims 7-10 depend from claim 6. Claims 12-15 depend from claim 11. Claims 17-20 depend from claim 16. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 2-5, 7-10, 12-15 and 17-20 are not anticipated by *Gombrich* for at least the reasons set forth above.

Examiner states that "shipping" is inherent in *Gombrich* because prescription drugs are useless if they are not delivered to the patient. *Gombrich* describes an

invention that has "application and utility to a variety of patient care facilities," including a hospital. See col. 9, lines 4-7.

MPEP 2112 provides that

[t]o establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Applicants respectfully point out to the Examiner that "...words in a claim are generally given their ordinary and customary meaning. ... A technical term used in a patent document is interpreted as having the meaning that it would be given by persons experienced in the field of the invention ..." *Vitronics Corp. v. Conceptronic Inc.* 39 USPQ2d 1573, 1576-1577. Thus, Applicants contend that the Examiner is required to interpret the claims of the present invention in accordance with the ordinary and customary meaning for the word "shipping," and in accordance with the meaning that the word "shipping" would be given by persons experienced in the field of the invention. Moreover, Applicants contend that "[t]he specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication. ... Thus, the specification is always highly relevant to the claim construction analysis. Usually it is dispositive; it is *the single best guide to the meaning of a disputed term.*" *Id.* at 1577. Therefore, Applicants further contend that the Examiner is required to interpret the claims of the present invention in accordance with the definition of the term "shipping" as set forth in the specification, e.g., at pages 13, 17, 18, 21, 22 and 28.

For example, a person of ordinary skill in the art would likely consider the following, which is in accordance with the ordinary and customary meaning of the word

“shipping” and which is supported in the specification, an acceptable example of the definition of the term “shipping”: transporting a product from a physical distribution facility to a shipping address. Accordingly, shipping, as that term is commonly understood by those of ordinary skill in the art and as that term is used in the specification, cannot be construed as a hospital or other patient care facility delivering a prescription drug to a patient in the hospital or other patient care facility. Consequently, shipping likely would not be recognized by a person of ordinary skill in the art as being present in *Gombrich* and thus is not inherent in *Gombrich*.

Twice amended Claim 6 recites the following:

A machine-readable medium having instructions stored thereon to implement an electronic commerce World Wide Web page, the sequences of instructions, when executed by one or more processors, cause one or more electronic systems to:

- provide access to a set of products available for electronic ordering by a user;
- monitor products ordered by the user; and
- provide, automatically, in response to subsequent accesses by the user a list of products previously ordered by the user.

Examiner contends that *Gombrich* discloses electronic commerce because, as the Examiner contends, *Gombrich* discloses a computer display used to order products, and the products are billed and paid for.

Applicants contend that the Examiner is required to interpret the claims of the present invention in accordance with the ordinary and customary meaning for the words “electronic commerce,” and in accordance with the meaning that the words “electronic commerce” would be given by persons experienced in the field of the invention. For example, whatis?com’s Encyclopedia of Technology Terms defines “electronic commerce” (also known in the art as e-commerce) as “buying and selling of goods and services on the Internet, especially the World Wide Web.” Moreover, Applicants contend that the Examiner is required to interpret the claims of the present invention in accordance with the definition of the term “electronic commerce” as set forth in the

specification, e.g., at pages 11-13. Accordingly, "electronic commerce," as that term is commonly understood by those of ordinary skill in the art and as that term is used in the specification, is not simply, as Examiner contends, using a computer display to order products, billing for the products and being paid for the products.

### CONCLUSION

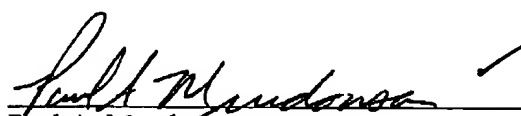
For at least the foregoing reasons, Applicants submit that the Examiner's rejections have been overcome. Therefore, claims 1-20 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,

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Application No. 09/480,731  
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VERSION OF CLAIMS MARKED TO SHOW CHANGES

1. (Twice Amended) A method comprising:  
providing access to a set of products available for electronic ordering by a user;  
monitoring products ordered by and shipped to an address associated with the  
user; and  
  
providing, automatically, in response to subsequent accesses by the user a list of  
products previously ordered by the user and shipped to the address.
4. (Amended) The method of claim 3 wherein reordering the product further  
comprises:  
determining [a location] an address to which the product was previously shipped;  
verifying the [location] address; and  
causing the reordered product to be shipped to the [location;] address.
6. (Twice Amended) A machine-readable medium having instructions stored  
thereon to implement an electronic commerce World Wide Web page, the sequences of  
instructions, when executed by one or more processors, cause one or more electronic  
systems to:  
  
provide access to a set of products available for electronic ordering by a user;  
monitor products ordered by and shipped to an address associated with the user;  
and  
  
provide, automatically, in response to subsequent accesses by the user a list of  
products previously ordered by the user and shipped to the address.

9. (Amended) The machine-readable medium of claim 8 wherein the sequences of instructions that cause the one or more electronic devices to reorder the product further comprise sequences of instructions that, when executed by the one or more processors, cause the one or more electronic systems to:

- determine [a location] an address to which the product was previously shipped;
- verify the [location] address; and
- cause the reordered product to be shipped to the [location;] address.

11. (Twice Amended) An apparatus comprising:

- means for providing access to a set of products available for electronic ordering by a user;
- means for monitoring products ordered by and shipped to an address associated with the user; and
- means for providing, automatically, in response to subsequent accesses by the user a list of products previously ordered by the user and shipped to the address.

14. (Amended) The apparatus of claim 13 wherein the means for reordering the product further comprises:

- means for determining [a location] an address to which the product was previously shipped;
- means for verifying the [location] address; and
- means for causing the reordered product to be shipped to the [location;] address.

16. (Twice Amended) A networked server device to provide information related to products available for ordering by a user of a client device coupled to the server, the server device to monitor products ordered by and shipped to addresses

associated with users that access the server device and to record products ordered by the users, wherein the server device provides one or more individual users, in response to subsequent accesses by the one or more individual users, with a list of products previously ordered by the respective users and shipped to the respective addresses.

19. (Amended) The server device of claim 18 wherein the server device reorders the product in response to the product being selected from the list, and determines [a location] an address to which the product was previously shipped, verifies the [location] address, and causes the reordered product to be shipped to the [location;] address.